

REMARKS

The Applicants thank the Examiner for the thorough consideration given the present application. Claims 1-21 are pending. Claims 1, 7, 8, 14, 15 and 21 are amended. Claims 1, 8, and 15 are independent. The Examiner is respectfully requested to reconsider the rejections in view of the amendments and remarks set forth herein.

Allowable Subject Matter

The Examiner states that claims 6, 13, and 20 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Applicants appreciate the Examiner's early indication of allowable subject matter. As indicated below, rather than rewriting any of objected to claims 6, 13, and 20 in independent form at this time, instead, independent claim 1, 8 and 15 are each amended herein to recite a novel combination of elements not suggested by the reference cited by the Examiner.

Therefore, independent claims 6, 13, and 20 are in condition for allowance.

Claim for Priority

It is gratefully acknowledged that the Examiner has recognized the Applicants' claim for foreign priority.

Acknowledgement of Information Disclosure Statement

The Examiner states that the Information Disclosure Statement (IDS) filed on November 3, 2003 is not compliant because a complete copy of JP 10-30501 was not provided. In response, the Applicants have attached a complete copy of JP 10-30501 with Form PTO-1449 as required. It is requested that the Examiner initial the Form PTO-1449 and forward a copy with the next office communication.

Rejection Under 35 U.S.C. §103(a)

Claims 1-5, 7-12, 14-19 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the background art in the present specification in view of Durdin, Jr. (U.S. Patent No. 2,355,713). These rejections are respectfully traversed.

While not conceding the appropriateness of the Examiner's rejection, but merely to advance prosecution of the instant application, independent claim 1 is amended herein to recite a combination of elements directed to a sealing structure for a direct acting auto-by starter, including an upper end of the volume varying means sealed around a small-diameter portion of a stem of the starting valve.

In addition, independent claim 8 is amended herein to recite a combination of elements directed to a sealing structure for a direct acting auto-by starter, including an upper end of the volume varying device axially sandwiched

between a flange and a shoulder formed on an upper end of a stem of the starting valve.

Further, independent claim 15 is amended herein to recite a combination of elements directed to a sealing structure for a direct acting auto-by starter, including a retainer secured to a body of the auto-by starter, said volume varying device being clamped around at least a portion of an outer surface of said retainer extending at least partially in an axial direction.

Support for the features set forth in claims 1, 8 and 15 can be found in the specification, for example in paragraph [0032] and seen in FIGS. 2 and 5.

Applicants respectfully submit that the combination of elements as set forth in each of independent claims 1, 8, and 15 is not disclosed or made obvious by the prior art of record, including Durdin, Jr.

As can be seen in FIG. 6 of Durdin, Jr., this document merely discloses a needle valve 74 with a substantially uniform diameter and lacking flanges or a small-diameter portion. Further, Durdin, Jr. is silent about a retainer. Instead, Durdin, Jr. merely discloses bellows attached to surfaces which are perpendicular the direction of expansion.

At least for the reasons set forth above, Applicants respectfully submit that the combination of elements as set forth in each of independent claims 1, 8, and 15 is not disclosed or made obvious by the prior art of record, including Durdin, Jr.

Therefore, claims 1, 8, and 15 are in condition for allowance.

The Examiner will note that dependent claims 7, 14, and 21 are amended to set forth more clearly novel aspects of the invention. See FIG. 5, for example, for support.

All dependent claims are in condition for allowance due to their dependency from allowable independent claims, or due to the additional novel features set forth therein.

Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) are respectfully requested.

CONCLUSION

Since the remaining patents cited by the Examiner have not been utilized to reject claims, but merely to show the state of the art, no comment need be made with respect thereto.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. It is believed that a full and complete response has been made to the outstanding Office Action, and that the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone Carl T. Thomsen (Reg. No. 50,786) at (703) 205-8000.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit

Applic. No. 10/609,403
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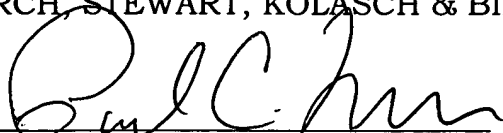
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Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly extension of time fees.


Respectfully submitted,

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